

Remarks

Applicant has amended claims 1, 15, 21, 26-28, 30 and 32. Applicant respectfully submits that no new matter was added by the amendment, as all of the amended matter was either previously illustrated or described in the drawings, written specification and/or claims of the present application. (Pars. 12, 15, 18 & 42) Entry of the amendment and favorable consideration thereof is earnestly requested.

The Examiner has rejected claims 1-4, 6, 7, 9, 12, 15-27 and 32 under 35 U.S.C. §103(a) as unpatentable over U.S. Patent No. 7,031,471 (Stefik et al.) in view of U.S. Patent No. 6,313,920 (Dresevic et al.). The Examiner has further rejected claims 28 and 30 under 35 U.S.C. §103(a) as unpatentable over Stefik et al. in view of Dresevic et al. and further in view of U.S. Patent Publication No. 2003/0177095 (Zorab et al.).

Claims 1 and 27 recite “security data specific to . . . each page of said digital file” and “a mark printed by said printer on each page of the printed digital file, said mark containing data unique to each page of the printed digital file.” Claim 15 recites “security data specific to each page of the digital file” and “at least two marks printed by said printer on the at least two pages of the printed digital file, said marks containing data unique to each of the at least two pages of the printed digital file.” Claims 21 and 26 recite “generating security data” that is “specific to each page of the digital file to be printed” and “a mark” that has “data unique to each page of the printed document [or file].” Claim 28 recites “security data” comprising “data specific to each page of said digital file and said mark further contains data unique to each page of said digital file.” Claim 30 recites “security data” comprising “data specific to each page of said digital file and said Optical Variable Device further contains data unique to each page of said digital file.” Claim 32 recites “security data specific to each page of said digital file” and “a mark printed by said printer on each page of the printed digital file, said mark containing data unique to each page of the printed digital file.” Accordingly, all of the pending

claims recite a mark that has data unique to each page of the document (or as claim 30 recites an Optical Variable Device that contains data unique to each page of the file).

The Examiner has submitted that while “Stefik et al fails to teach a mark containing data specific to each page of the printed digital file”; that “Dresevic et al teaches a mark containing data specific to each page of the printed digital file (identifiers for all of the glyphs in the TextOut call which have not been used on previous pages in the document) (col. 10, lines 1-14).” (Official Action 12/10/07, p. 3)

Applicant respectfully submits that Dresevic et al. fails to teach or disclose has data that is unique to each page. For example, a major problem Dresevic et al. is provided to address is with respect to remote printing and states “[o]ne reason remote printing may consume so much network bandwidth is because any font contained in the document to be printed that is not installed on the print server at the time of printing must be downloaded . . . before printing can begin.” (Col. 1, Ins. 35-38) Dresevic et al. further states that “there is a large amount of information for each glyph in each font which describes how the glyph’s shape is to be formed at various sizes.” (Col. 1, Ins. 42-44) In particular, “Far East” fonts present a major challenge. (Col. 2, Ins. 25-30) To address this problem, Dresevic et al. provides a system that “incrementally subsets fonts on a page-by-page basis” where “a document to be printed . . . is analyzed by page to determine the fonts used on each page and which characters, or glyphs, from each font are needed to print the page.” (Col. 2, In. 66 – Col. 3, In. 4)

The section of the specification in Dresevic et al. pointed to by the Examiner (Col. 10, Ins. 1-14) describe the use of incremental subsets of fonts or glyphs. For example, Dresevic et al. states “identifiers for all the glyphs in the TextOut call which have not been used on previous pages in the document are added to a second list associated with the font, called the “DeltaGlyphs” list” and the “DeltaGlyphs list contains identifiers for all the additional glyphs of the font necessary to print the current page.” (Col. 10, Ins. 1-6) Accordingly, Dresevic et al. has nothing to do with security, security marks or pro-

viding marks unique to each page of a document. Rather, Dresevic et al. is concerned with a method for reducing the printing time of a document containing a font with characters or glyphs that may not be installed on a printer.

A rationale to support a conclusion that a claim would have been obvious is that all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded nothing more than predictable results to one of ordinary skill in the art. *KSR International Co. v. Teleflex Inc.*, 550 U.S. ___, ___, 82 USPQ2d 1385, 1395 (2007); *Sakraida v. AG Pro, Inc.*, 425 U.S. 273, 282 (1976). In the present case, Dresevic et al. does not teach “a mark containing data” or even simply “data” unique to each page of the printed file. The glyphs the Examiner has pointed to are font information (e.g. a Chinese character) that may appear on the page to be printed. This glyph information is used on every page where the particular character appears and therefore, is not unique to each page. Therefore, as all the claimed elements were not known in the prior art, no combination therefore can render the pending claims obvious. See, *KSR International Co. v. Teleflex Inc.*, 550 U.S. ___, ___, 82 USPQ2d 1385, 1395 (2007).

Additionally, it is well settled that if the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. MPEP 2143.01; *In re Gordon*, 733 F.2d 900, 221 USPQ2d 1125 (Fed. Cir. 1984). In the present case, Applicant respectfully submits that it would not be obvious to modify Dresevic et al. to include a mark or even data unique to each page as the glyphs are provided as part of an “incremental font subsetting” which is usable for each page. (Col. 1, Ins. 10-11; See, Col. 3, Ins. 7-9 which describes the creation of a “spool file” including glyphs that are used in the document and are quickly accessible by the printer.) To modify Dresevic et al. to require each character to have a specific glyph works contrary to the teaching of Dresevic et al., which states that the “present invention solves all of the above-described

problems by minimizing the number of glyphs transmitted to the print server." (Col. 3, Ins. 15-17) Accordingly, such a modification cannot be obvious.

It is respectfully submitted that claims 1-28, 30 and 32, all of the claims remaining in the application, are in order for allowance and early notice to that effect is respectfully requested.

Respectfully submitted,

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/Wesley W. Whitmyer, Jr./

Wesley W. Whitmyer, Jr., Registration No. 33,558
Steven B. Simonis, Registration No. 54,449
Attorneys for Applicant
ST. ONGE STEWARD JOHNSTON & REENS LLC
986 Bedford Street
Stamford, CT 06905-5619
Tel. 203 324-6155